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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,373

11/14/2003

Seiji Katsuoka

2003-1659A

9589

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7590

06/24/2009

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EXAMINER

LAMB, BRENDA A

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

06/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/712,373	Applicant(s) KATSUOKA ET AL.	
	Examiner Brenda A. Lamb	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-17, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-17 and 22-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1792

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14-17 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 02/47139 (EBARA CORPORATION).

EBARA CORPORATION '139 teaches as shown in Figures 52 and 54B which is comprised of a substrate processing unit. EBARA CORPORATION '139 is comprised of the following elements: a substrate receiving ring 900 to which a seal ring is mounted; a vertically movable substrate holder or seal press 908 having a substrate fixing ring movable as shown by arrows in Figure 52 so as to hold a substrate by nipping a peripheral portion of the substrate between the substrate fixing ring 609 and the seal ring 906 to seal the peripheral portion of the substrate during processing of the substrate; and a temporary retaining section that is mounted to the substrate receiving ring and positioned around the seal ring to temporarily retaining the substrate thereon while forming a space between the substrate and the seal ring; wherein the substrate receiving ring and the substrate fixing ring hold the substrate with its front surface facing downward; and wherein the temporary retaining section is comprised of a plurality of temporary retaining pins 902 as shown in Figure 54A having a forward tapered surface which are biased upwardly by an elastic member, and which inherently must lower integrally with the substrate holder against the elastic force of the elastic member from its position as shown in Figure 52 in order to seal the edge portion with seal ring 906 so as to prevent contact of the treatment fluid with the retaining pins, and inherently return to the original position as the substrate holder rises due to the elasticity of spring 910. The recitation that the tapered end surface of the temporary retaining pins contacts a peripheral end surface of the substrate and the temporary retaining pins also includes a retaining portion projecting outwardly for receiving the peripheral lower surface of the substrate

Art Unit: 1792

does not structurally further limit the applicant's apparatus over EBARA CORPORATION '139 since EBARA CORPORATION '139 is capable of accepting substrates having a variety of diameters including those having a diameter such that tapered end surface of the temporary retaining pins contacts a peripheral end surface of the substrate and the temporary retaining pins also includes a retaining portion projecting outwardly from the tapered portion for receiving the peripheral lower surface of the substrate. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus EBARA CORPORATION '139 teaches every positively claimed structural element of the apparatus set forth in claim 14. With respect to claim 15-17, EBARA CORPORATION '139 shows in Figure 52 that the lower surface of the substrate to be treated faces downwardly and below the lower surface is an open area as defined by the combination of wafer and substrate receiving ring into which a catalyst-imparting medium, pre-plating medium or pre-plating treatment medium is capable of being applied. With respect to claim 22, the EBARA CORPORATION '139 shows a portion of the head portion of each of the temporary retaining pins projects outwardly of the tapered surface in a horizontal direction as shown in Figures 54A-54B. With respect to claim 23, EBARA

Art Unit: 1792

CORPORATION '139 shows in Figures 52-53 in an alternate embodiment that the top of its substrate contacting pins has a flat top surface. EBARA CORPORATION '139 fails to teach that substrate contacting pins as shown in Figure 54B has a flat top surface. However, it would have been obvious to modify the EBARA CORPORATION '139 substrate contacting pins as shown in Figure 54B such that its tip end is a flat top surface for the obvious advantage of increasing the life of the pins by reducing the occurrence of chipping of the tip increasing the thickness of the end of the pins and especially since EBARA CORPORATION '139 teaches in an alternate embodiment as shown in Figure 52-53 that its substrate contacting pins has a flat top surface.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's argument that EBARA CORPORATION '139 substrate contacting pins as shown in Figure 54B are electric terminals and do not contact a peripheral end surface of the substrate is found to be non-persuasive. As discussed above, EBARA CORPORATION '139 is capable of accepting substrates having a variety of diameters including those having a diameter such that tapered end surface of the temporary retaining pins contacts a peripheral end surface of the substrate and the temporary retaining pins also includes a retaining portion projecting outwardly from the tapered portion for receiving the peripheral lower surface of the substrate. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus

Art Unit: 1792

satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton, can be reached on (571) 272-1465. The

Art Unit: 1792

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A Lamb
Primary Examiner
Art Unit 1792

/Brenda A Lamb/

Primary Examiner, Art Unit 1792